UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILFRIED JUD and HANS-RUDOLF NAGELI

Appeal No. 2006-1061
Application No. 09/505,713

HEARD: May 09, 2006

Before KRATZ, TIMM and JEFFREY T. SMITH, ***Administrative Patent Judges***.

JEFFREY T. SMITH, ***Administrative Patent Judge.***

DECISION ON APPEAL

Applicants appeal the decision of the Examiner finally rejecting claims 38 to 53, all of the pending claims. We have jurisdiction under 35 U.S.C. §134.[1]

---

[1] In rendering this decision, we have considered Appellants' arguments presented in the Brief, filed February 2, 2004.

CITED PRIOR ART

As evidence of unpatentability, the Examiner relies on the following references:

Breitler et al. (Breitler)	5,589,275	Dec. 31, 1996
Muggli[2]	5,968,663	Oct. 19, 1999

Ullmann's Encyclopedia of Industrial Chemistry, 1998 VCH, vol. A11, pp. 85, 86, 93, 105 and 108-108. (Ullmann)

The Examiner entered the following rejections:

(I). Claims 38-43 stand rejected under 35 U.S.C. § 102 (b) as anticipated by Breitler. (Answer, pp. 3-4).

(II). Claims 38-53 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Breitler and Ullmann. (Answer, pp. 4-6).

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the Examiner and Appellants in support of their respective positions. This review leads us to conclude that the Examiner's § 102 rejection is not well founded however, the § 103 rejection is well founded. Our reasons follow.

---

2. The Examiner as rebuttal evidence to Appellants' arguments cited this reference. The reference has not been included in the statement of the rejection.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants concerning the above-noted rejections, we refer to the Answer and the Brief.

We initially note that Appellants assert that for purposes of appeal the claims are grouped as follows: (I) 38-45 and 47-50, (II) 46, (III) 51, (IV) 52 and 53. We will consider these groups of claims separately to the extent that Appellants have argued them. Any claims not properly separately argued will stand or fall with the selected representative claim. See 37 CFR § 1.192(c)(7)(2003)(now 37 CFR § 41.37(c)(1)(vii), effective Sept. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)); and ***In re McDaniel,*** 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002).

OPINION

Appellants' invention relates to a sterilizible composite film containing a barrier layer that is impermeable to water vapor and gases comprising a metal foil and on both sides of the barrier layer at least one functional layer. Claim 38, which is representative of the claimed invention, appears below:

> 38. A sterilizable composite film containing a barrier layer that is impermeable to water vapor and gases comprising a metal foil and on both sides of the barrier layer at least one functional layer,

> the composite film having a layer structure containing one on top of the other in the following sequence:
>
> (a) a first functional layer containing a plastic film that is a polyester, a polyamide, or a polyolefin, or an extrusion layer of a polyolefin, or one or more lacquer layers, or print and lacquer layers, or print layers;
>
> (b) a metal foil having a thickness of 5 to 100 pm; and
>
> (c) a second functional layer containing a plastic layer that is a layer comprising a coextrusion-coated, a coextruded, and/or an extrusion-laminated film having a sequence of a first polypropylene layer, a polyamide layer, and a second polypropylene layer, said first polypropylene is directly bonded to metal foil (b) or is bonded to metal foil (b) by means of a bonding agent layer or a laminate adhesive layer, and, optionally, a primer layer is on at least one surface of metal foil (b).

The Examiner rejected claims 38-43 as anticipated by Breitler. Claim 38 is directed to a sterilizable composite film containing a barrier layer that is impermeable to water vapor and gases comprising a metal foil and on both sides of the barrier layer at least one functional layer. The composite film has a layer structure containing layers one on top of the other in a specific sequence.

We agree with Appellants that the Examiner has not established a *prima facie* case of anticipation with respect to the subject matter of the rejected claims. (Brief, p. 6). The Examiner acknowledges in the discussion of the § 103 rejection that there must be some selection from the teachings of

Breitler to arrive at the claimed invention. (See Answer, p. 5). As such, Breitler does not anticipate the claimed subject matter because it does not provide a disclosure sufficiently specific to direct one skilled in the art to the claimed combination without any need for picking and choosing. ***See In re Arkley***, 455 F.2d 586, 589, 172 USPQ 524, 527 (CCPA 1972). Accordingly we determine that the Examiner has not established a *prima facie* case of anticipation with respect to the subject matter of claims 38-43.

However, our determination that the disclosure of Breitler does not anticipate the subject matter of the claims does not preclude a finding that the disclosure of Breitler would have rendered the subject matter of the claims on appeal *prima facie* obvious under 35 U.S.C. § 103 (a). ***See Arkley, supra.***

Claims 38-53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Breitler in view of Ullmann. We affirm the rejection essentially for the reasons presented by the Examiner and add the following primarily for emphasis.

We note that Appellants' representative in the Hearing on May 9, 2006, indicated that the appeal as to the subject matter of claim 51 is withdrawn. Thus, we summarily affirm the Examiner's § 103 rejection of claim 51.

We now turn to the rejection of the remaining claims.

The Examiner found that Breitler teaches a composite film containing a metal foil, preferably aluminum, with plastic films on both sides thereof. According to the Examiner, Breitler teaches the general layer structure as instantly claimed with layer thickness within or comprising the instantly claimed ranges. Breitler teaches utilizing optional adhesive, bonding and/or primer layers to bond plastic layers to each other and/or to the metal foil. The Examiner asserts that "[t]hough Breitler et al discloses all of the layers, layer materials and layer thickness as instantly claimed, Breitler et al does not specifically limit the invention to the specific composite film combination as instantly claimed, however, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize any of the structures disclosed by Breitler et al selecting from the disclosed materials taught by Breitler et al based on the desired film properties for a particular end use." (Answer, p. 5). The Examiner determined that through routine

experimentation it would have been obvious to a person of ordinary skill in art to determine the optimum thickness of the individual layers because layer thickness is a result-effective variable affecting the barrier, mechanical, adhesion and sealing properties of the resulting composite. (Answer, p. 5). Further, the Examiner determined, citing the Ullmann reference, that utilization of an appropriate laminating method, such as extrusion laminating, lamination coating, coextrusion or laminating via adhesives would have been obvious to a person having ordinary skill in the art. (Answer, p. 5).

The major point of disagreement between Appellants and the Examiner is the description of the subject matter of Breitler in column 4. Appellants argue that:

> The Examiner has incorrectly contended that column 4 of Breitler et al. discloses appellants' second functional layer (c).
>
> The disclosure in column 4 of Breitler et at., when taken in context with the entire disclosure of such patent, refers to a sealable layer on one or both sides of its composite material (and not to a sealable layer on both sides of a polyamide layer of said composite material). Appellants have presented below an analysis of column 4 and its meaning in the context of the whole disclosure of Breitler et al. and the wording in such column. Appellants have also presented court and Board decisions on it being in error to take portions of a prior art reference out of context. Further, appellants have presented quotations from

documents from the prosecution/examination of Breitler et al. to support appellants' position. [Brief, p. 5].

Appellants further argue, Brief page 13, that "[a]ll references to sealing layers in such text [of column 4] are exclusively to sealing layers, located on the outer surfaces of the composite material, i.e. on the outer surface of the plastic layers of the composite material."

Appellants' argument is not persuasive. Breitler provides an extensive discussion of the various layers that form the described composite material. (See columns 2-7). Regarding the plastic layer, Breitler discloses:

> The plastic layers may include e.g. monofilms or monolayers and composites of two or more films or layers of plastics such as polyamides, polyamide mixtures or mixed, block, grafted or copolyamides. [Column 3, lines19-22] . . . .
>
> The plastic layers on both sides of the metal layer, in particular the polyamide-based thermoplastics may additionally, and independent of each other, be provided with an outer lying sealable layer and/or a barrier layer of thermoplastics. [Column 4, lines, 9-13] . . . .
>
> A single or double-sided sealable composite is obtained by single or double-sided coextrusion of the plastic layers with e.g. a polypropylene/polyethylene copolymer.
>
> In that connection it is useful for the plastic layers to contain or comprise of a polyamide-based thermoplastic and at least one a polyamide-based thermoplastic to feature a sealing layer on at least one side i.e. **each layer of polyamide**-based thermoplastic may be covered with a sealable layer on one or **both sides**, **independent** of the other layers. [Column 4, lines 36-45].

(Emphasis added)

Breitler teaches a person of ordinary skill in the art, from the above cited portions of the disclosure, *inter alia*, that the plastic (polyamide) layer may be composites of two or more layers and that the sealing of the plastic layer on one or both sides is independent of the other layers. As such, a person of ordinary skill in the art would have reasonably expect that both sides of the plastic layer described by Breitler could have been encased by sealing layers. "For obviousness under ' 103, all that is required is a reasonable expectation of success." ***In re O'Farrell,*** 853 F.2d 894, 904, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). This is especially true in the present case because Breitler, like the present application, adheres the materials of the sealing layer to the metal foil layer. (See column 5). Consequently, a person of ordinary skill in the art would have recognized that if the sealing layers were applied to both sides of the polyamide layer the (encased) plastic layer would have been suitable for bonding to the metal layer.

Appellants have presented the declaration of Breitler to discuss the descriptions appearing in column 4 of the cited U.S. Patent No. 5,589,275 (Breitler). The declarant states

> Such text [column 4, lines 9-13] is not discussing the plastic layers by themselves but only as components in the structure of the basic composite material. The use of the phrase "outer lying sealable layer" refers only to the outside surfaces of the basic composite material (i.e., the outside surface of each of the plastic layers). The words "outer lying" refer only to the side of each of the plastic layers away from the metal foil." (Paragraph 6)
>
> Such text [column 4, lines 36-45] only discusses the basic composite material, placement of a sealable layer on the outer or outside surface of at least one of the plastic layers in the basic composite method. Such text does not refer to one or both of [the] sides of a plastic layer (in the composite material) having a sealable layer thereon—such is not part of the invention described in U.S. Patent No. 5,589,275. (Paragraph 7).

The statements of the declarant are not persuasive of patentability. The declarant did not indicate that the description of Breitler was not suggestive of treating each layer of the composite independent of other layers. A person of ordinary skill in the art would have reasonably interpreted the description of Breitler as suggesting that the plastic (polyamide) layer was formed from composites of two or more layers. A person of ordinary skill in the art would have also reasonably interpreted that the description of Breitler suggested that the plastic (polyamide) layer contained sealing layers on

both sides, independent of the other layers in the composite material.[3] It is well settled that a prior art reference is relevant for all that it teaches to those of ordinary skill in the art. **See *In re Fritch***, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1782 (Fed. Cir. 1992). The intention of the patentee not to include specific subject matter in the described patent does not detract from the suggestive teachings therein.

The Examiner cited the Ullmann reference for teaching that the formation of plastic multilayer films by the process of extrusion laminating, lamination coating, coextrusion and laminating with adhesives were known. (Answer, p. 5). Breitler discloses the processes such as those described in Ullmann are suitable for forming composite materials used in packaging. (Column 6, lines 21-24). Thus, Appellants' arguments that there is no motivation to combine Breitler and Ullmann, Brief pages 27, 32 and 33, are not persuasive.

Appellants, Brief page 35, questions whether the Muggli reference is part of the § 103 rejection. The Muggli reference has not been included in

---

3. We note that Appellants' interpretation of the description of Breitler as having a sealing layer on the outside surfaces of the basic composite material is also consistent with the description of the reference.

the statement of the rejection by the Examiner. The Examiner relied on this reference as rebuttal evidence to Appellants' arguments. (Answer, p. 9).

Appellants argue that, because the Examiner has not addressed on the record the level of skill in the art, the § 103 rejection is fatally defective. (Brief, p. 36). "While it is always preferable for the factfinder below to specify the level of skill it has found to apply to the invention at issue, the absence of specific findings on the level of skill in the art does not give rise to reversible error 'where the prior art itself reflects an appropriate level and a need for testimony is not shown.'" ***Okajima v. Bourdeau***, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001), (**quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.***, 755 F.2d 158, 163, 225 USPQ 34, 38 (Fed. Cir. 1985). Appellants have not explained, and it is not apparent, why the applied prior art does not reflect an appropriate level of skill in the art.

For the above reasons and those expressed by the Examiner, we determine that the Examiner has established a *prima facie* case of obviousness with respect to the subject matter of claims 38-45 and 47-50.

Regarding claims 46, 52 and 53, Appellants argue that Breitler does not disclose or suggest a polypropylene layer between the metal foil and the

polyamide layer. (Brief, pp. 37-40). This is essentially the same argument presented in the discussion of claim 38. As stated above, Breitler is suggestive of a composite material comprising a sealing layer on both sides of the plastic (polyamide) layer. Breitler discloses the sealing layer can be formed from polypropylene. (Column 4, lines 21-35). Thus, we affirm the rejection of claims 46, 52 and 53.

After considering all the evidence, with due consideration to the Appellants' arguments and evidence, we determine that the Examiner has established a *prima facie* case of obviousness with respect to the subject matter of claims 38-53, which has not been sufficiently rebutted by Appellants.

CONCLUSION

The rejection of claims 38-43 under 35 U.S.C. § 102 (b) as unpatentable over Breitler is reversed. The rejection of claims 38-53 under 35 U.S.C. § 103 (a) as unpatentable over Breitler and Ullmann is affirmed.

TIME FOR TAKING ACTION

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(iv)(effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED

PETER F. KRATZ
Administrative Patent Judge

CATHERINE TIMM
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

JTS/sld

FISHER CHRISTEN & SABOL
1725 K STREET NW
SUITE 1401
WASHINGTON, DC 20006